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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 09/863,116 | 05/22/2001 | Farrukh S. Najmi | SUN1P298 | 9186 |
| 22434 | 7590 | 10/06/2004 | EXAMINER | |
| BEYER WEAVER & THOMAS LLP | | | OSMAN, RAMY M | |
| P.O. BOX 778 | | | ART UNIT | PAPER NUMBER |
| BERKELEY, CA 94704-0778 | | | 2157 | |

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/863,116 | NAJMI, FARRUKH S. | |
| | Examiner | Art Unit | |
| | Ramy M Osman | 2157 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 May 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) 5 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 5 objected to because of the following informalities:

Change the word “arrange” to “arranged” on page 11, line 22.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,4,5,8,9 and 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. ‘Topic Subscriber’ has not been explicitly defined and will therefore be interpreted as a target destination.

4. Claims 4,8 and 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The wording of claim 4 is unclear and does not allow accurate reading of the claim. Is the transformation being applied to the XML message or to the topic subscriber?

Examiner requests applicant to reword the claims.

Examiner suggests the following type of rewording or a variation of it:

... wherein if the determining step (b) determines that the XML message conforms to a different schema from that specified with the XSLT filter, then sending the original untransformed XML message to the topic subscriber.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1,3-5,7-9,11 and 12 rejected under 35 U.S.C. 102(a) as being anticipated by IBM Corporation (cross reference # 0374-4353-42-423-0).

7. In reference to claims 1,5 and 9, IBM teaches method of service side filtering of a message in a distributed network, comprising:

(a) determining if the message is to be sent to a topic subscriber; (b) determining if the message is an extensible markup language (XML) message that conforms to an XML schema specified by a selected XSLT filter; (c) transforming the XML message to form a modified XML message; and (d) sending the modified XML message to the topic subscriber. (page 1, page 2 lines 1-35 and page 3 lines 1-40)

IBM teaches a message transmitted on a network Applying an XSL template to an XML document. Formatting the XML document. And, sending the XML document to its destination.

8. In reference to claim 3,7 and 11, IBM teaches the method as provided in claim 1, wherein the transforming is based up the specified XSLT filter and an associated XSLT engine. (page 1; IBM teaches a Transformation Engine)

9. In reference to claim 4,8 and 12, IBM teaches the method as recited in claim 1, wherein if determining (b) determines that the XML message conforms to a different schema than specified with the XSLT filter, then sending the XML message without any transformation to the topic subscriber. (page 1 and page 2 lines 1-35; IBM teaches that “when patterns are matched” within the XML document then it is transformed. It is inherent that when patterns are not matched, then no transformation takes place and the document continues transmission over the network.)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2,6 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over IBM Corporation (cross reference # 0374-4353-42-423-0) in view of Laitinen (XML Messaging, Tik-11.590).

IBM teaches the method as recited in claim 1. IBM fails to explicitly teach wherein the determining (a) is performed by a JMS provider. However, Laitinen teaches that it is well known

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in the art for a JMS provider to handle messages between applications and components.

(Laitinen; sections: 2.5.3, 2.5.7, 2.5.12, 2.5.13)

It would have been obvious for one of ordinary skill in the art to incorporate into IBM a JMS provider as per the teachings of Laitinen so as to implement message handling between applications and components.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M Osman whose telephone number is (703) 305-8050. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO

September 23, 2004


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
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